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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,379	02/24/2004	Bcn Huang	WINN.11CP5DVI	6581
20995 7590 09/18/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER BLAU, STEPHEN LUTHER	
			ART UNIT 3711	PAPER NUMBER
			NOTIFICATION DATE 09/18/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcarter@kmob.com  
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# Office Action Summary

Application No.

10/785,379

Applicant(s)

HUANG, BEN

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/23/07,1/22/07, 9/26/06,12/22/05,11/28/05, 4/26/04.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 28 November 2005 and 25 September 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the patent number does not match inventors name of item 1 of IDS dated 28 November 2005 and item 67 of IDS dated 26 September 2006. It has been placed in the application file, but the information referred to therein for these two references have not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

2. The two information disclosure statements filed 28 November 2005 and 22 December 2005 fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the court papers are not relevant to the processing of this case. During the litigating process of a prior patent, if prior art or other information material to the patentability of pending claims is discovered that is relevant to a pending case at the patent office the applicant is required to disclose this discovery under 37 CFR 1.97, 37

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CFR 1.98, and 37 CFR 1.56. However it is neither desired nor required to submit to the Patent Office every declaration, objection, answer, order, reply, opposition, deposition transcript etc... that is filed in a court litigating a previous patent. Since it appears that every court paper is being submitted on a civil case it is clear no thought is being given to the information as it relates to the pending claims of this case. This is an intense burden on the examiner. Litigating the validity of patents in courts is a completely different process compared to processing a patent application at the U.S. Patent Office. Courts have no set time to decide a case while at the Patent Office the processing of a case is limited by time. In this particular art for this case the examiner has only 6 hours to read and understand an invention, review disclosed prior art, perform a search and write a position for a first office action. Clearly reviewing numerous pages of court papers that were submitted in this case with no logic related to the relevance of the claims of this pending application would take a significant portion of this 6 hours if not the entire allotted time or more the examiner has to complete a first office action. And as the litigating process continues the examiner sees no end point to the number of pages of court papers which will be submitted in this case or future cases. If every attorney practicing before the Patent Office did the same as being done in the cases the applicant has before the Patent Office, it would bring the Patent Office to a complete stop in terms of being able to perform its job. Plus the examiner thinks it inappropriate to comment on papers being filed during the litigation of a patent before a court since the approval of patents at the Patent Office and the litigation of the validity of patents in the court are two independent and different processes with different procedures,

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standards and time frames. It is not the examiner's roll to comment on every court paper which is being submitted before a court. In the past it has been the practice for applicants to use court decisions to argue cases before the Patent Office and not tie up the Patent Office with court papers that will be used to decide cases before a court. As such, due to the nonsensical submission of court papers in this case the examiner will not consider court papers on Information Disclosure Statements filed by the applicant.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 21-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,695,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims are more broad in that these claims replace felt with fabric and remove the step of spirally wrapping grip material on a sleeve which is an obvious step in placing a grip material on a sleeve.

5. Claim 23 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,695,713 in view of Falco (5,343,776).

Claims 1 and 5 of U.S. Patent No. 6,695,713 lacks a first and second set of fibers comprising equal diameters.

Falco discloses a fabric which is impregnated with a elastomer where the strands have the same size (Fig. 1c). In view of the patent of Falco it would have been obvious to modify the grip of claims 1 and 5 of U.S. Patent No. 6,695,713 to have a first and second set of fibers comprising equal diameters in order to use a fabric used in the market place which is impregnated with an elastomer used as an handle grip cover.

6. Claims 21-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-6, 11 and 16 of U.S. Patent No. 6,695,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is the number of segments for the grip. If there is a two segment grip with all the patentable features than it would be

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obvious to have a one segment grip with all the patentable features since most grips have just one segment.

### ***Allowable Subject Matter***

7. Claims 21-23 would be allowable if rewritten or amended to overcome the double patenting rejection set forth in this Office action. None of the prior art discloses or renders as obvious a method having a first fabric, a second fabric having parallel fibers and perpendicular extending fibers, overlapping the first and second fabric layers, applying liquid polyurethane to first and second fabric layers, coagulating the liquid polyurethane such that the polyurethane layers bonds the first and second fabric in addition to the other elements of structure claimed.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Slb/12 September 2007

  
STEPHEN BLAU  
PRIMARY EXAMINER